

REMARKS

This Amendment is filed in response to the Office Action mailed September 16, 2008. All rejections and objections are respectfully traversed.

Claims 1 – 12, 31, 32, and 34 – 52 are pending in the case.

Claims 1, 31, 32, 34, and 48 have been amended to better claim the invention.

Claims 49 – 52 have been added.

Request for Interview

The Applicant respectfully requests a telephonic interview with the Examiner after the Examiner has had an opportunity to consider this Amendment, but before the issuance of the next Office Action. The Applicant may be reached at 617-951-2500.

Claim Rejection – 35 USC §101

At paragraphs 3 and 4 of the Office Action, claims 34 – 40 were rejected under 35 USC §101 as being directed to non-statutory subject matter. Applicant respectfully submits that the Amendment to independent claim 34 satisfies the rejection.

Claim Rejection – 35 USC §103

At paragraphs 5 and 6 of the Office Action, claims 1 – 12, 31 – 32, and 34 – 48 were rejected under 35 USC §103 as being unpatentable over Baker, U.S. Patent No. 6,473,741 (hereinafter “Baker”), in view of Carver, U.S. Publication No. 2004/0078307 (hereinafter “Carver”).

Applicant’s claimed novel invention, as set forth in representative claim 1, as amended, comprises in part:

1. A financial services outsourcing method for facilitating a direct service provider’s management of human resources for providing financial

services to numerous clients, the financial services being outsourced to an outsourcing group abroad, the method comprising:

prioritizing tax returns for outsourcing, wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced;

for plural respective direct services providers, loading, onto a remotely accessible part of a common host server located in a given country, client specific financial files and corresponding reference materials, the host server providing access to a remote computer client of information concerning the client specific financial files and corresponding reference materials;

retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country;

providing the outsourced personnel limited access to the server, *the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country;* and

monitoring and reporting the status of the tax return preparation and of the other financial service projects.

By way of background, Baker discloses a system and method for the electronic exchange of tax data between those in the financial service industry. (See Baker, col. 5, lines 34 - 39). Specifically, tax preparation firms submit their databases of income tax data for archival and later retrieval by requesting organizations (“*as a result of automated tax preparation, these accounting and tax firms have warehouses of databases of tax returns in digitized format.*” See Baker, col. 8, lines 46 – 49). A service bureau then organizes the data from the different firms and coordinates dissemination of the data for a rental fee or user fee to third parties. (See Baker, col. 8, lines 65 – 67). Third parties then retrieve the data for the fee and utilize the data to obtain patterns and relationships that are otherwise not readily evident. (See Baker, col. 2, lines 46 – 51).

Carver discloses a system and method for “conducting, tracking, storing and analyzing various financial and tax-related transactions over a computer network such as

the internet.” (See Carver, paragraph [0016]). Specifically, Carver utilizes various independent software programs and internet web sites that are already in existence to perform the tax and financial analysis. (See Carver, paragraph [0026]). “The data of any particular user that is recorded and stored in a secure database is automatically input into one or more of these downloadable programs on demand to generate a variety of financial and tax-related documents for that user.” (See Carver, paragraph [0027]).

Applicant respectfully submits that Baker and Carver, either alone or in combination, fail to teach or suggest Applicant’s claimed novel “prioritizing tax returns for outsourcing, wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced” AND “retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country” AND “the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country.”

In short summation, Applicant claims are directed to prioritizing tax returns and utilizing outsourced personnel to perform tax return preparation services, while Baker and Carver have no disclosure of these features.

First, Applicant respectfully submits that both references are completely silent with respect to Applicant’s claimed novel outsourced personnel performing tax return preparation services.

Specifically, the Examiner states, “Baker does not explicitly disclose... providing financial services to numerous clients, the financial services being outsourced to an outsourcing group abroad.” (See Office Action, page 4).

Instead the Examiner asserts that paragraph [0027] of Carver teaches this feature of Applicant’s claim. (See Office Action, pages 4 – 5). Applicant respectfully disagrees.

Outsourcing, as know by individuals skilled in the art, is the process of

“contracting with another company or person to do a particular function.” (See http://www.sourcingmag.com/content/what_is_outsourcing.asp). Said differently, outsourcing includes seeking “resources outside of an organizational structure, usually to save money and/or exploit the skills of another entity.” (See <http://www.webopedia.com/term/o/outsource.html>). Applicant’s Specification reiterates this notion stating, “[n]on-accounting industries such as banking and insurance have been outsourcing various data processing tasks to India. Suggestions have been made to accounting firms to outsource tax return preparation services to India, to thereby reduce the per-return labor cost experience by the accounting firm. There is a need for systems and methods to facilitate such outsourcing.” (See Applicant’s Specification, page 1).

With this definition in mind, Applicant respectfully submits that Carver has no disclosure of **outsourcing** tax return preparation services, as is claimed by Applicant.

Specifically, paragraph [0027] of Carver states:

“data of any particular user that is recorded and stored in a secure database is automatically input into one or more of these downloaded programs on demand to generate a variety of financial and tax-related documents for the user...Further discussion and advice may be sought from the online tax and accounting professionals at the inventive web site, if necessary.”
(Emphasis added).

Therefore, the text above of Carver says is silent with regard to of outsourcing but merely states that tax accounting documents can be produced for users on demand by Carver’s web site. Applicant respectfully notes that a web site is not equivalent to outsourcing as is known by those skilled in the art and as is claimed by Applicant. Specifically, as noted above, outsourcing entails using a person/company **outside the organizational structure** to provide a service to save money and/or exploit the skills of the other person/company. Carver is completely silent with respect to outsourcing, and instead merely discloses a website where tax and accounting professional, who work for Carver’s website, can perform financial tasks for different users who decide to utilize Carver’s website. Said differently, the tax and accounting professionals who produce the tax-related documents are **not** outsourced individuals. Instead, these individuals are merely employees of the Carver website. Therefore, Carver fails to teach or suggest Applicant’s claimed novel **outsourcing tax return preparation services**.

Accordingly, Applicant respectfully submits that Baker and Carver, either alone or in combination, are legally insufficient to render the present claims unpatentable under 35 USC §103 because of the absence in Baker and Carver of Applicant's claimed novel *retaining outsourced personnel to perform tax return preparation services for clients of the direct service providers during a tax season in a given year and to perform other financial service projects for the clients of the direct service providers during a different season of the given year, the outsourced personnel preparing the tax returns and performing the other financial service projects while in an outsource country different from the given country*" AND "*the outsourced personnel performing the tax return preparation services during the tax season in the given year and performing the financial service projects during a different season of the given year through a remote limited access client located in the outsource country.*"

Further, Applicant respectfully submits that both references are completely silent with respect Applicant's claimed novel *prioritizing tax returns, wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced.*

For example, Applicant's novel claimed system may act in the following illustrative manner,

lowerend (smaller priced tax return services for individual tax filers) can be outsourced to the outsourcing group, allowing the United States personnel to work on higher-end (i.e. higher priced tax returns and other CPA services for corporations and businesses)...thus allowing the higher-rate US personnel to put priority attention to the higher-margin, higher rate services required by corporation and businesses. (See Applicant's Specification, page 4, first full paragraph).

First, the Applicant respectfully notes that the Examiner does not assert that Baker teaches this portion of Applicant's novel claim. In fact, the Examiner states, "Baker does not explicitly disclose...prioritizing tax returns for outsourcing." (See Office Action, page 4).

Instead, the Examiner asserts that paragraph [0027] of Carver teaches this portion of Applicant's novel claim. (See Office Action, page 4 – 5).

Applicant respectfully disagrees. Specifically, paragraph [0027] is completely silent with respect to prioritizing tax returns where a tax return with a lower priority is outsourced before a tax return with a higher priority, as is claimed by Applicant. Instead, paragraph [0027] of Carver merely states that Carver's website can provide users with various financial and tax-related documents.

Accordingly, Applicant respectfully submits that Baker and Carver, either alone or in combination, are legally insufficient to render the present claims unpatentable under 35 USC §103 because of the absence in Baker and Carver of Applicant's claimed novel "prioritizing tax returns for outsourcing, wherein a tax return with a lower priority is outsourced before a tax return with a higher priority is outsourced".

Conclusion

All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance. Accordingly, all dependent claims are believed to be in condition for allowance.

Favorable action is respectfully solicited.

Please charge any additional fee occasioned by this paper to our Deposit Account
No. 03-1237.

Respectfully submitted,

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